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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,078	07/25/2003	Bruce A. Marrale	5180-000007	3122
28997	7590	09/30/2005	EXAMINER	
HARNESS, DICKEY, & PIERCE, P.L.C. 7700 BONHOMME, STE 400 ST. LOUIS, MO 63105			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/627,078	MARRALE, BRUCE A.
	<b>Examiner</b>	<b>Art Unit</b>
	Gregory Pickett	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 July 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 25-34 is/are allowed.

6)  Claim(s) 1-3,7 and 11-24 is/are rejected.

7)  Claim(s) 4-6 and 8-10 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 July 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931). Claim 22 uses the trademark SESAME. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the display portion" in line 1. There is insufficient antecedent basis for this limitation in the claim. To examine the claims on their merits, the examiner interprets claim 19 to depend from claim 18.

Claims 20-24 are dependent on claim 19 and are rejected for the above reason.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Desrosiers et al (US 6,073,833; hereinafter Desrosiers).

Claim 1: Desrosiers discloses a convertible shipper container **10** comprising a top panel **5**, a bottom panel **6**, a front side **1**, a left side **3**, a back panel **4**, and a right side **2**. Desrosiers pictorially shows a perforated line **30** for separation but anticipates a separation strip (Col. 3, lines 17-19). Desrosiers discloses hand holes **60** which, when opened just prior to separation of the top portion of the container, form a partially open front side on panel **1** and first and second slots on right and left sides **2 & 3**. Desrosiers separates as claimed (see Figures 1 and 5).

Claim 2: Desrosiers discloses slots **60** on the right and left sides extending partially across a width with separation strip **30** extending across the remainder of the width.

Claim 3: Desrosiers discloses slots **60** collinear with separation strip **30**.

Claim 7: Desrosiers discloses a convertible shipper container **10** comprising a top panel **5**, a bottom panel **6**, a front panel **50**, a left side **3**, a back panel **4**, and a right side **2**. Desrosiers pictorially shows a perforated line **30** for separation but anticipates a separation strip (Col. 3, lines 17-19). Desrosiers discloses hand holes **60** which, when opened just prior to separation of the top portion of the container, form a window on panel **1**, the bottom portion of which is defined by the top of panel **50**, and first and second slots on right and left sides **2 & 3**, the slots communicating with the window on the front by means of separation strip **30**. Desrosiers separates as claimed (see Figures 1 and 5).

4. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Morse et al (US 4,058,206; hereinafter Morse).

Inasmuch as the applicant is claiming the blank and not the container formed by the blank, Morse discloses a blank (Figure 4) comprising:

a first section **14, 22 & 23** including a top panel **14**, a left side primary flap **22** connected to top panel **14** by means of top first side fold line **24**, and a right side primary flap **23** connected to top panel **14** by means of top second side fold line **25**;

a second section **15, 26 & 27** connected to the first section along a first major fold line **19**, the second section including a back panel **15**, a left side secondary flap **26** connected to the back panel **15** along a back left side fold line **28**, a right side secondary flap **27** connected to the back panel **15** along a back right sides fold line **29**,

and a separation strip **46** having a first portion in the left side secondary flap **26**, a second portion included in the back panel **15**, and a third portion included in the right side secondary flap **27**;

a third section **16, 30 & 31** connected to the second section along a second major fold line **20**, the third section including a bottom panel **16**, a left side tertiary flap **30** connected to the bottom panel **16** along a bottom left side fold line **32**, a right side tertiary flap **31** connected to the bottom panel **16** along a bottom right side fold line **33**; and

a forth section **17, 34 & 35** connected to the third section along a third major fold line **21**, the forth section including a front wall **17**, a left side quaternary flap **34** connected to the front wall **17** along a front wall left side fold line **36**, and a right side quaternary flap **35** connected to the front wall **17** along a front wall right side fold line **37**.

Morse is capable of being folded as claimed. The recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. Portion **49** of the blank is configured for separation along separation strip **47**. As such, with portion **49** removed, the blank of Morse is considered to be "configured to" form a window in a partially open front side. It is noted that the applicant is only claiming the blank and that folding the blank in any specific manner is deemed intended use, wherein the prior art need only be capable of folding in the claimed manner to anticipate the claim.

5. Claims 1, 2, 7, and 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Malin (GB 2 088 830 A).

Claim 1: Malin discloses a convertible shipper container (first embodiment, Figures 1-3) comprising a top panel **5**, a bottom panel **3**, a front side **9**, a back panel **7**, left and a right sides (portions with separation strips **23 & 25**), and separation strips **23 & 25** which have portions on the left, right and back sides. The side flaps of Malin do not contact one another (see Figures 1 and 2); therefore, the gaps therebetween constitute first and second slots on the left and right sides. Malin separates as claimed (see Figure 2).

Claim 2: the slots of Malin have a width (narrow dimension) that extends partially across the width (narrow dimension) of the sides. Since the separation strips intersect the slots, they are considered to continuously extend from the slot across the remainder of the width of the sides.

Claim 7: the container of Malin, as applied to claim 1 above, discloses the claimed invention, including the front panel having a top end (lowest portion of opening **17**) defining a window **17**.

Claim 11: inasmuch as the applicant is claiming the blank and not the container formed by the blank, Malin discloses a blank (Figure 3) comprising:

a first section **5 & 15** including a top panel **5**, a left side primary flap **15** connected to top panel **5** by means of top first side fold line **13**, and a right side primary flap **15** connected to top panel **5** by means of top second side fold line **13**;

a second section **7 & 15** connected to the first section along a first major fold line **11**, the second section including a back panel **7**, a left side secondary flap **15** connected to the back panel **7** along a back left side fold line **13**, a right side secondary flap **15** connected to the back panel **7** along a back right sides fold line **13**, and a separation strip **23 & 25** having a first portion in the left side secondary flap **15**, a second and fourth portion included in the back panel **7**, and a third portion included in the right side secondary flap **15**;

a third section **3 & 15** connected to the second section along a second major fold line **11**, the third section including a bottom panel **3**, a left side tertiary flap **15** connected to the bottom panel **3** along a bottom left side fold line **13**, a right side tertiary flap **15** connected to the bottom panel **3** along a bottom right side fold line **13**; and

a forth section **9 & 15** connected to the third section along a third major fold line **11**, the forth section including a front wall **9**, a left side quaternary flap **15** connected to the front wall **9** along a front wall left side fold line **13**, and a right side quaternary flap **15** connected to the front wall **9** along a front wall right side fold line **13**.

Malin is capable of being folded as claimed. The recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. The portion at the far right end of the blank (as viewed in Figure 3) is configured for separation along separation strip **23 & 25**. As such, with the portion at the far right end of the blank removed, the blank of Malin is considered to be "configured to" form a window in a partially open front side. It is noted that the applicant is only claiming the blank and that folding the blank in any specific manner is deemed intended

use, wherein the prior art need only be capable of folding in the claimed manner to anticipate the claim.

Claims 12-22: The recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. Malin, with the portion at the far right end of the blank (as viewed in Figure 3) removed, is capable of being folded as claimed. Inasmuch as the applicant is claiming the blank and not the container formed by the blank, Malin anticipates the claims.

***Allowable Subject Matter***

6. Claims 25-34 appear to define over the prior art.
7. Claims 4-6 and 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 23 and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
23 September 2005

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700